Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MARTIN KOLKER and HORST SERGEL

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Appeal No. 2001-0093
Application No. 08/947,149

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HEARD: Apr. 9, 2002

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Before GARRIS, WARREN, and MOORE, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 1-14, 16 and 18 as amended subsequent to the final rejection. These are all of the claims remaining in the application.

The subject matter on appeal relates to a process for transporting a belt construction strip via first and second

conveying devices which comprises a number of steps including the step of "laterally aligning the belt construction strip, in a region between the front tip and the rear tip [of the belt constructions strip], in accordance with its position and without a lateral stop to guide either of the lateral sides [of the belt construction strip]." Further details of this appealed subject matter are set forth in representative independent claim 1, a copy of which taken from the appellants' brief is appended to this decision.

The following reference is relied upon by the examiner as evidence of obviousness:

Regterschot et al. (Regterschot) 5,720,837 Feb. 24, 1998 (filed Aug. 1, 1995)

All of the appealed claims are rejected under 35 U.S.C. § 103 as being unpatentable over Regterschot.

We cannot sustain this rejection.

A pivotal issue on this appeal is whether the aforequoted "laterally aligning" step of appealed claim 1 distinguishes over Regterschot. The appellants argue that it does. The examiner, on the other hand, expresses his contrary position in the following manner on page 8 of the answer:

> As briefly noted above, it can also be reasonably considered that the present claim language does not even exclude the presence of such upstream lateral

> guides. In particular, as explained more fully in the preceding paragraphs, the lateral guides in Regterschot et al. only provide some preliminary straightening of the material rather than actually functioning in laterally aligning the tire belt strip in accordance with its position. Such lateral alignment of the tire belt strip in accordance with its position occurs solely in the transition region through lateral movement of the first conveyor responsive to sensors located in this region. Thus, this reference can reasonably be considered to be performing this alignment/adjustment without lateral guides or stops as claimed.

It is axiomatic that, in proceedings before the Patent and Trademark Office, claims in an application are to be given their broadest reasonable interpretation consistent with the specification. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In so interpreting appealed claim 1, we find that the "laterally aligning" step recited therein must be uncategorically performed pursuant to the literal meaning of the claim recitation "without a lateral stop to guide either of the lateral sides [of the belt construction strip]." Indeed, to interpret otherwise would be inconsistent with the disclosure of the subject specification concerning the objective to be achieved via the appellants' invention (e.g., see lines 20-22 on specification page 1 and lines 15-18 on specification page 8).

The examiner is correct that Regterschot's process includes a "laterally aligning" step (e.g., see lines 29-32 in column 7

and lines 18-27 in column 8). Nevertheless, it is clear that patentee's "laterally aligning" step includes the use of guide rollers 16 (e.g., see Figures 3, 4 and 6 as well as lines 25-27 in column 7 and lines 3-5 in column 10). Since the here claimed "laterally aligning" step must be performed "without a lateral stop . . .," Regterschot's corresponding step must be regarded as different because it includes the use of lateral stops in the form of guide rollers 16.

As an alternative theory in support of his rejection, the examiner argues that it would have been obvious to eliminate the roller guides of Regterschot. This position is expressed in the paragraph bridging pages 6 and 7 of the answer with the following language:

> [W]hile it would have been understood that some assurance that the tire belt strip is generally in the right position upon approaching the transition region is important, the ordinary artisan would have readily appreciated that the way in which this is accomplished is not a critical or fundamental feature of the Regterschot et al. invention. Further, it is submitted that the artisan would have readily understood the impact of lateral guides on the strip material and been able to balance the desire for this type of preliminary guiding versus the possibility for damage to the strip. The ordinary artisan further is considered to be adequately equipped with adequate skill to design a device consistent with the Regterschot et al invention that nevertheless does not require edge guides, appropriate care being taken on positioning the material that such guides are unnecessary. - note that appellants have not indicated (and do not claim) that

> any particular means or technique is followed (other that the laterally moving conveyor) to allow omission of these guides. Either using these guides, omitting these guides and their function or omitting these guides in favor of other equivalent techniques of accomplishing their function (e.g. manually) would therefore again have been obvious alternatives and lead to only the expected results.

This obviousness conclusion is not well founded. The applied reference simply contains no teaching or suggestion of eliminating guide rollers 16. Stated otherwise, the reference contains nothing which would have motivated one with ordinary skill in the art to so modify the Regterschot process. In this latter regard, the examiner seems to believe that an artisan would have been motivated to eliminate patentee's guide rollers 16 in order to avoid "the possibility for damage to the strip" (id.). However, the applied reference contains utterly no disclosure concerning this possibility. In the record before us on this appeal, only the appellants have disclosed the possibility for damage to the belt construction strip due to use of a lateral stop.

Under these circumstances, we regard the examiner's conclusion of obviousness as being inadequately supported by evidence. It is our perception that, in formulating the rejection before us, the examiner has fallen victim to the insidious effect of hindsight syndrome wherein that which only

the inventor has taught is used against its teacher. W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed Cir. 1983), cert. denied, 469 U.S. 851 (1984). We are constrained to conclude, therefore, that the examiner has failed to carry his burden of establishing a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In summary, the examiner's section 103 rejection of all appealed claims as being unpatentable over Regterschot cannot be sustained.

The decision of the examiner is reversed.

REVERSED

Bradley R. Garris Administrative Patent Judge	)	
Charles F. Warren Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
James T. Moore Administrative Patent Judge	)	

BRG:tdl

Appeal No. 2001-0093
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APPENDIX

1. A process for transporting a belt construction strip having parallel reinforcing members embedded in a belt construction material for forming a belt for a pneumatic vehicle tire in an apparatus that includes a first and second conveying device arranged to transport the belt construction strip in a feed direction, and the first conveying device is arranged for movement in a direction lateral to the feed direction, comprising:

feeding the belt construction strip in the feed direction over the first and second conveying devices toward a subsequent processing device, the feed direction being oblique to the reinforcing members and the belt construction strip including two lateral sides extending in the feed direction;

forming a front edge on a front end of the belt construction strip in the feed direction and a rear edge on a rear end of the belt construction strip in the feed direction, the front and rear edges extending obliquely to the feed direction and substantially parallel to the reinforcing members;

defining a front tip from a portion of the belt construction strip enclosed by the front edge and one of the two lateral sides;

defining a rear tip from a portion of the belt construction strip enclosed by the rear edge and the other of the two lateral sides;

laterally moving the first conveying device in a direction lateral to the feed direction to align the front tip at a specified lateral position;

laterally aligning the belt construction strip, in a region between the front tip and the rear tip, in accordance with its position and without a lateral stop toY guide either of the lateral sides; and

laterally moving the first conveying device in a direction lateral to the feed direction to align the rear tip at a specified position.